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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,551	12/14/2000	Satoshi Kidooka	P20361	6566

7055 7590 03/24/2004

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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/735,551	Applicant(s) KIDOOKA, SATOSHI	
	Examiner Ann Y. Lam	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 29 is/are allowed.
- 6) ☒ Claim(s) 6-12, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 recites that the first wall surface is discontinuous with the second wall surface. This claim limitation however is contrary to the drawings, which show that the first (23) and second wall (22) surfaces are continuous in that they connect with each other. Thus, it is unclear as to what Applicant is claiming.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-12, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Nita et al. 5,916,192.

Nita et al. disclose a liquid supply tube (62, Infusion part, in Figure 2); a treatment instrument channel (60, in Figure 2) configured to insertably accept the liquid supply

tube; and a cap member (20 and 32) to be provided in a leading end of a spraying device, the leading end affixed to the liquid supply tube, the cap member comprising: a cylindrical portion defining an interior of the cap member, see Figure 3; and a leading end wall (see distal end of 20 and 32) at a leading end of the cylindrical portion, the leading end wall separating the interior of the cap member from an exterior thereof, the leading end wall comprising: a spray nozzle (see distal end of 20 and 32), a first wall surface (see distal end of 32) in the exterior of the cap member, the first wall surface extending radial outwardly from an outer periphery of the spray nozzle, and a second wall surface (see distal end of 16) in the exterior of the cap member, the second wall surface extending longitudinally outwardly from an outer periphery of the first wall surface.

As to claim 7, the first wall surface (distal end of 32) is conical, see Figure 3.

As to claim 8, the first wall surface is curved in section, see Figure 3.

As to claim 9, the first wall surface is planar in section, see Figure 3.

As to claim 10, the first wall surface is planar.

As to claim 11, the second wall surface (distal end of 16) extends radially inwardly from the periphery of the first wall surface.

As to claim 12, the second wall surface extends radially outwardly from the periphery of the first wall surface.

As to claim 30, the liquid supply tube (62, infusion part in Figure 2) is substantially coaxial with the spray nozzle.

As to claim 31, since it is unclear as to what Applicant is claiming (see 112 rejection above), the first wall surface (23) is considered discontinuous with the second wall (22) surface.

Response to Arguments

Applicant's arguments filed December 24, 2003 have been fully considered but they are not persuasive.

Applicant argues on page 7 that the first wall surface and second wall surface identified by Examiner are actually a unitary curved surface rather than two separate wall surfaces as claimed.

In response, Examiner asserts that nothing in the claims preclude the wall surface from being a curved surface, and that newly added claim 31 is indefinite (see above). Furthermore, in Applicant's invention, the first and second wall surfaces are also unitary.

Applicant argues on page 7 that the Nita device does not spray but rather infuses, and that the dictionary definition of spray is a jet of vapor or finely divided liquid. In response, Examiner asserts that the Nita device is capable of spraying during the infusion, to the extent that there will be some finely divided liquid. Examiner emphasizes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a

process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

Claims 1-5, and 29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the combination of elements including a liquid rotating chamber configured to rotate liquid therein, and a spray nozzle was not found in the prior art search.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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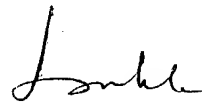
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703)305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

A.L.



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

03/22/04